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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,899	10/15/2003	Sandeep Kulkarni	57349.D1 (CSP-025549-V1)	6249
1726 7590 03/14/2008 INTERNATIONAL PAPER COMPANY 6285 TRI-RIDGE BOULEVARD LOVELAND, OH 45140			EXAMINER CAMERON, ERMA C	
			ART UNIT	PAPER NUMBER
			1792	
			MAIL DATE	DELIVERY MODE
			03/14/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/685,899	Applicant(s) KULKARNI ET AL.	
	Examiner /Erma Cameron/	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-65 is/are pending in the application.
- 4a) Of the above claim(s) 31-32, 34 and 64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20,27,33,35-39,53-63 and 65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Election/Restrictions

1. The applicant has stated in the 12/6/2007 amendment that claims 31-32, 34 and 64 and withdrawn as being drawn to nonelected species. However:

a) Claims 34 and 64 are given the status identifier “previously presented”. This should be “withdrawn” instead.

b) Claims 35 and 36 have been given the status identifier “withdrawn”. This should be “previously presented”.

Claims 27-30, 33, 35-39, 53-63 and 65 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claim 54 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claims 54: “improved” is vague in that the basis of comparison is not known.

(Note: corrections were made to claims 56 and 63 in the 12/6/2007 amendment.)

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 27-30, 37, 39, 53, 54, 56-59 and 63 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by WO 99/63157.

‘157 teaches a paper or paperboard with a basis weight such as 200 g/m² (= 123 lb/ 3000 square feet) (3:7-26) and a basecoat of starch or other materials, with an ink-receptive layer on top that comprises acrylic polymers and additives such as polyvinyl alcohol (6:24-9:23). The improved durability, resistance to staining and storageability are inherent to the coatings.

Response to Arguments

The applicant has argued that the instant application has an ink receptive layer that is used to prevent smudges or feathering, and that the starch of claim 27 is used to penetrate partially into the sheet of paper, thus distinguishing it from '157. However, none of these parameters are in claim 27 as written.

The applicant further argues that '157 teaches a publishing paper as in Example 14 and does not teach a "hold" (must have meant "holdout") layer. The examiner disagrees. '157 teaches a printing paper with a basecoat with starch and improved ink holdout (1:1-22; 2:1-8; 9:7-23). Furthermore, '157 teaches coating a variety of papers, such as annual reports, advertising brochures and fine papers (4:13-22), and not just the uncoated basecoat paper of Example 14.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 33, 38, 55 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/63157.

'157 is applied here for the reasons given above.

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'157 does not teach the water absorption range, but because the coatings are similar to those claimed by applicant, the water absorption range of the '157 paper or paperboard are expected to overlap with that claimed by applicant.

The ink receptive layer is 0.5-10 g/m² (0.37-6.1 lb per 3000 sf) (4:13-22) which overlaps with the coat weight claimed by applicant.

Response to Arguments

The applicant has argued that the examiner has modified the '157 reference towards the claimed invention. The examiner disagrees. There is no modification made to '157 in the above rejection.

8. The rejection of Claims 27-30, 33, 35-39, 53-59, 63 and 65 under 35 U.S.C. 103(a) as being unpatentable over JP 08-337078 is withdrawn.

Response to Arguments

The applicant has argued that '078 does not disclose a holdout layer and therefore the rejection should be withdrawn.

The examiner disagrees with this reasoning. The examiner believes that '078 does show a starch base/holdout layer 3. The reason the rejection is being withdrawn is because the layer 4 over the starch layer is not an ink-receiving layer, but rather an ink layer.

9. The rejection of Claims 60-62 under 35 U.S.C. 103(a) as being unpatentable over JP 08-337078 taken in view of EP 880892 is withdrawn for the reason given above.

10. Claims 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/63157 taken in view of Malhotra (5709976).

‘157 is applied here for the reasons given above.

‘157 fails to teach that the ink receiving layer has a biocide.

‘976 teaches a coated paper with a barrier layer and an ink receiving layer over the barrier layer that comprise a biocide, as well as acrylic emulsions (see Abstract; 6:61-65; 12:1-6; 23:9-24:25).

It would have been obvious one of ordinary skill in the art to have added the biocide of the ‘976 ink receiving layer into the ‘157 paper because of the teaching of ‘976 that such a biocide is conventional in an acrylic containing ink receiving layer.

11. Claims 60-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/63157 taken in view of Malhotra (5709976) and further taken in view of EP 880892.

‘157 and ‘976 are applied here for the reasons given above.

Neither reference teaches the biocides of claims 60-62.

‘892 teaches that 3-iodo-2 propynyl butyl carbamate (4:25) is a microbiocide that may be used in paper coatings (5:8-19).

It would have been obvious to one of ordinary skill in the art to have substituted the biocide of '976 with the carbamate biocide of '892 with the expectation of success in controlling bacterial growth.

Claim Objections

12. The rejection of Claim 58 is withdrawn because of the 12/6/2007 amendment.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Erma Cameron/ whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Erma Cameron/
Primary Examiner
Art Unit 1792

March 1, 2008